

Applicant : Gregg D. Wilensky
Serial No. : 09/747,945
Filed : December 21, 2000
Page : 2 of 6

Attorney's Docket No.: 07844-484001 / P448

REMARKS

Claims 1-98 are pending and stand rejected. Claims 1, 20, 49, 50, 51, and 98 are in independent form.

There appears to be an error in the Office Action. At paragraph 3 of page 2, claim 1 is rejected under Section 102(e). However, the rejection is made under the Section 103 heading and in reliance on not one but two references. Furthermore, the Examiner recognizes that neither of the applied references discloses all limitations of claim 1. The rejection, thus, appears to be a Section 103 rejection, and Applicant addresses the rejection as such.

Claim 1 stands rejected under 35 U.S.C. Section 102(e) (assumed to be 103(a)) as being unpatentable over U.S. Patent No. 6,570,624 B2 to Cornog et al ("Cornog") in view of U.S. Patent No. 6,721,446 to Wilensky et al. ("Wilensky"). Applicant respectfully traverses the rejection.

Claim 1 recites a method that includes "receiving a first input defining a first border region . . . , the first border region further including *only a part of the foreground portion* and *only a part of the background portion*" and "receiving a second input defining a second border region . . . , the second border region further including *only a part of the foreground portion* and *only a part of the background portion*." (Emphasis added.) As can be seen, each of the claimed border regions includes only a part of the foreground portion and only a part of the background portion.

The Examiner contends that Cornog (specifically FIG. 4A) discloses or suggests the claimed border region. In particular, the Examiner contends that the item labeled as FG1 is the foreground portion, that the item labeled as BG is the background portion, and that the item labeled as FG1 is the claimed border region. *See* Office Action, at p. 2, paragraph 3. Applicant must respectfully disagree because FG1 does not include *only* a part of the foreground portion and *only* a part of the background portion of a first digital image, as required by claim 1. Cornog's FG1 includes all of the foreground region. Furthermore, as can be seen in FIG. 4A, FG1 does not include any part of BG and, thus, does not include a part of the background portion, as required by claim 1. Thus, Cornog fails to disclose or suggest the claimed border

Applicant : Gregg D. Wilensky
Serial No. : 09/747,945
Filed : December 21, 2000
Page : 3 of 6

Attorney's Docket No.: 07844-484001 / P448

region. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Moreover, Wilensky should be disqualified as prior art. 35 U.S.C. 103(c) provides that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under Section 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Here, the present application, U.S. Application No. 09/747,945, and Wilensky, U.S. Patent No. 6,721,446, were, at the time the invention of the present application was made, owned by or subject to an obligation of assignment to Adobe Systems Incorporated. According to M.P.E.P. Section 706.02(1)(2), this statement provides sufficient evidence to disqualify Wilensky from being used in a rejection under 35 U.S.C. 103(a) against the claims of the present application. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Claim 1 also stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 6,556,704 B1 to Chen ("Chen") in view of Wilensky. The applicant respectfully traverses the rejection.

The Examiner contends that Chen (specifically FIG. 1) discloses or suggests the claimed border region. In particular, the Examiner contends that item 14a, which represents a person, discloses the border region. *See* Office Action, at p. 4, paragraph 4. The applicant must respectfully disagree because item 14a constitutes all of foreground in the image and, thus, does not include *only* a part of the foreground portion, as required by claim 1. Furthermore, as can be seen in FIG. 1, item 14a does not include any part of the background portion and, thus, cannot include only a part of the background portion, as required by claim 1. Thus, Chen fails to disclose or suggest the claimed border region. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Moreover, as discussed above, Wilensky should be disqualified as prior art. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

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Applicant : Gregg D. Wilensky
Serial No. : 09/747,945
Filed : December 21, 2000
Page : 4 of 6

Attorney's Docket No.: 07844-484001 / P448

Claim 1 also stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 6,128,046 to Totsuka et al. ("Totsuka") in view of Cornog. The applicant respectfully traverses the rejection.

The Examiner recognizes that Totsuka fails to disclose or suggest the claimed border region but contends that Cornog does. As discussed above, Cornog fails to disclose or suggest the claimed border region. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Claim 1 also stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 5,912,994 to Norton et al. ("Norton") in view of Cornog. The applicant respectfully traverses the rejection.

The Examiner recognizes that Norton fails to disclose or suggest the claimed border region but contends that Cornog does. As discussed above, Cornog fails to disclose or suggest the claimed border region. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Claim 1 also stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 6,429,875 B1 to Pettigrew et al. ("Pettigrew") in view of Cornog. The applicant respectfully traverses the rejection.

The Examiner recognizes that Pettigrew fails to disclose or suggest the claimed border region but contends that Cornog does. As discussed above, Cornog fails to disclose or suggest the claimed border region. For at least this reason, the applied references do not render claim 1 and its dependent claims obvious.

Claim 20 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cornog and Wilensky, over Chen and Wilensky, over Norton and Cornog, and over Pettigrew and Cornog. Claim 20 recites a method that includes "receiving an input defining an initial border region . . . , the initial border region further including only a part of the foreground portion and only a part of the background portion." For reasons similar to those discussed above, the applicant respectfully submits that the applied references do not render claim 20 and its dependent claims obvious.

Claim 49 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Chen and Wilensky, over Totsuka and Cornog, over Norton and Cornog, and over Pettigrew and

Applicant : Gregg D. Wilensky
Serial No. : 09/747,945
Filed : December 21, 2000
Page : 5 of 6

Attorney's Docket No.: 07844-484001 / P448

Cornog. Claim 49 recites a method that includes "receiving a first user input defining a first border region . . . , the first border region further including only a part of the object and only a part of the background." For reasons similar to those discussed above, the applicant respectfully submits that the applied references do not render claim 49 obvious.

Claim 50 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cornog and Wilensky, over Chen and Wilensky, over Totsuka and Cornog, over Norton and Cornog, and over Pettigrew and Cornog. Claim 50 recites a computer program product including instructions to "receive a first input defining a first border region . . . , the first border region further including only a part of the foreground portion and only a part of the background portion." For reasons similar to those discussed above, the applicant respectfully submits that the applied references do not render claim 50 and its dependent claims obvious.

Claim 51 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cornog and Wilensky, over Chen and Wilensky, over Norton and Cornog, and over Pettigrew and Cornog. Claim 51 recites a computer program product including instructions to "receive an input defining an initial border region . . . , the initial border region further including only a part of the foreground portion and only a part of the background portion." For reasons similar to those discussed above, the applicant respectfully submits that the applied references do not render claim 51 and its dependent claims obvious.

Claim 98 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cornog and Wilensky, over Norton and Cornog, and over Pettigrew and Cornog. Claim 98 recites a computer program product including instructions to "receive a first user input defining a first border region . . . , the first border region further including only a part of the object and only a part of the background." For reasons similar to those discussed above, the applicant respectfully submits that the applied references do not render claim 98 obvious.

PTO FORM-1449

On August 4, 2004, Applicant submitted an information disclosure statement with a PTO Form-1449. To date, Applicant has not received an initialed and signed copy of the PTO form-1449, the return of which is hereby respectfully requested.

Applicant : Gregg D. Wilensky
Serial No. : 09/747,945
Filed : December 21, 2000
Page : 6 of 6


Attorney's Docket No.: 07844-484001 / P448

CONCLUSION

Applicant asks that all pending claims be allowed. No fee is believed to be due. Please apply appropriate charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Feb. 14, 2005



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